

REMARKS

This paper is filed in response to the official action dated February 10, 2006 (hereinafter, the official action).

Claims 54-69 are pending. Claims 54-60 and 62-69 have been rejected. Claim 61 has been objected to, but is allowable in substance. The drawings are objected to under 37 C.F.R. §1.83(a). By this amendment, the drawings and specification are amended. Support for the amendments to the drawings may be found in the specification as originally filed, specifically, support may be found at page 24 in the paragraph beginning at line 15. The amendments to the specification are made as a result of the amendments to the drawings. No new matter is added.

Claims 54, 55-59, 62, and 63 have been rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,911,569 to Hashimoto et al. ("Hashimoto"). Claim 60 has been rejected under 35 U.S.C. §103(a) as obvious over Hashimoto in view of U.S. Patent No. 4,617,697 David ("David"). Claims 64-69 have been rejected under 35 U.S.C. §103(a) as obvious over Hashimoto in view of David and U.S. Patent No. 4,385,024 to Tansill ("Tansill").

The bases for the objection to the drawings and the various claim rejections are addressed below in the order presented in the official action. Reconsideration of the application, as amended, is solicited in view of the following remarks.

OBJECTION TO THE DRAWINGS

The applicants respectfully traverse the objection to the drawings. The applicants note that neither claim 64 nor claim 68 recite "a tube being inserted between the first and second ends of the tubular member." Therefore, the applicants assume the examiner was referring to claim 65 in his objection to the drawings because claim 65 recites "a tube [being] inserted between the first and second ends of the tubular member." Fig. 7A is amended to show the tube recited in claim 65, and the tube is given reference number 350. As a result, the drawings are in proper form and show every element recited in the pending claims. Thus, the applicants respectfully request withdrawal of the objection to the drawings.

35 USC § 102 REJECTIONS

The applicants respectfully traverse the rejections of claims 54-59, 62, and 63 as anticipated by Hashimoto. It is well-established that each and every limitation of a claimed invention must be present in a single prior art reference in order for anticipation to occur. See, for example, *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998). The standard for anticipation is one of strict identity. This standard has not been satisfied with respect to claims 54-59, 62, and 63.

Each of claims 54-59, 62, and 63 recites a writing instrument comprising a deformable sleeve having a sealable passageway defined between adjacent ends of a base and an outer membrane. Hashimoto fails to disclose a writing instrument comprising a sealable passageway. Rather, Hashimoto discloses writing instrument comprising an elastic envelope 35 having an inner wall 44 and an outer wall 55 that are separated by a front end wall 45 and a rear end wall 54 (col. 10, lines 23-38). The passageway 6 identified in the official action (at page 4) does not include a sealable portion formed by adjacent ends of the inner wall 44 and the outer wall 55. The inner wall 44 and the outer wall 55 are physically separated and thus could not form a sealable passageway. Furthermore, there is no need to make the annular fluid chamber 6 sealable because the annular fluid chamber 6 is filled with fluid by injecting fluid into the chamber 6 with a syringe through two normally closed inlets 47 (FIG. 9) formed in the outer wall 55 (col. 10, lines 27-32). Because Hashimoto fails to disclose a sealable passageway defined between adjacent ends of the tubular base and outer membrane, as recited in claims 54-59, 62, and 63, claims 54-59, 62, and 63 are not anticipated by Hashimoto, and the anticipation rejections should be withdrawn.

35 USC § 103 REJECTIONS

The applicants respectfully traverse the rejections of claims 60 and 64-69 as obvious over Hashimoto in view of one or more of David and Tansill (collectively the "cited art"). Neither David nor Tansill address the deficiencies of Hashimoto discussed above.

A *prima facie* case of obviousness must satisfy three legal requirements. First, there must be some suggestion or motivation, either in the references themselves, or in knowledge generally available to one of ordinary skill in the art, to modify the

reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See* M.P.E.P. §2143. These criteria have not been satisfied with respect to pending claims 60 and 64-69.

CLAIM 60

Claim 60 recites a writing instrument comprising a deformable sleeve having a sealable passageway defined between adjacent ends of a base and an outer membrane. As shown above, Hashimoto fails to disclose or suggest a writing instrument comprising a deformable sleeve having a sealable passageway defined between adjacent ends of a base and an outer membrane. Likewise, David fails to disclose or suggest a writing instrument comprising a deformable sleeve having a sealable passageway defined between adjacent ends of a base and an outer membrane.

David discloses a moldable handle adapter for golf clubs and tennis rackets; the David device is essentially a closed pouch, having two sections, a larger section 10 and a smaller section 12 joined by a lap joint 14 (col. 2, lines 21-24, see also FIG. 1). The two pouch sections are formed and filled with a moldable plastic material prior to disposing the pouch on a tool (col. 2, lines 47-55). This moldable plastic material, includes two parts that rapidly harden when brought together. *See* David col. 2, lines 29-46. Thus, the plastic material of the David device can only adapt to the grip of a single user, unlike the deformable tubular sleeve of the instant application, which “conforms to the fingers of different users.” *See*, the instant application, page 23, lines 3-7.

Moreover, David teaches that the overlapping walls 16 and 18 should form a strong lap joint. *See* David, col. 5, lines 31-34. The lap joint 14 is closed and impenetrable, and thus does not provide a sealable passageway in fluid communication with a cavity, as recited in claim 60. Thus, the applicants respectfully request withdrawal of the rejection of claim 60.

CLAIMS 64-69

None of the cited art discloses or suggest a method of forming a tubular sleeve on a writing instrument having an elongate body defining first and second ends and a writing mechanism projecting from the first end comprising providing an elongate tubular member of flexible material having a first end, a second end, a larger diameter

portion, and a smaller diameter portion; folding the smaller diameter portion back through the larger diameter portion so that the first end is adjacent the second end, thereby to form the tubular sleeve with a generally tubular base defining an inner surface and a generally tubular outer membrane concentric with the base, a cavity being defined between the base and outer membrane, placing the generally tubular base over the body so that the inner surface engages the body near the writing mechanism, separating the first and second ends of the tubular member to define a passageway in fluid communication with the cavity, passing formable material through the passageway to fill the cavity, and sealing the first and second ends of the tubular member to close the passageway. For example, the cited art fails to disclose or suggest a method of forming a tubular sleeve on a writing instrument including separating first and second ends of a tubular member to define a passageway in fluid communication with a cavity.

As shown above, neither Hashimoto nor David discloses or suggests a deformable sleeve having a sealable passageway defined between adjacent ends of a base and an outer membrane. As a result, neither Hashimoto nor David disclose or suggest separating first and second ends of a tubular member to define a passageway in fluid communication with a cavity.

Similarly, Tansill discloses a shoe insert (container 10) having an upper wall 11 and a lower wall 12 (col. 5, lines 60-65) defining a cavity filled with a liquid material 13 and curing agent 15 (col. 6, lines 2-19). Like the David device, the moldable material of the Tansill device is custom fitted for a single user (after curing). Again, this is in contrast to the deformable tubular sleeve of the instant application, which can conform to the fingers of different users. While an alternate embodiment of the Tansill device may be filled through a tube 62 (misabeled 32 in Fig. 11), the tube 62 (32) is not sealable, nor does the tube 62 (32) have first and second ends which can be separated to define a passageway in fluid communication with a cavity. See, Tansill col. 9, lines 6-12. Moreover, there is no need to seal along line 69 (39) because Tansill's curable material hardens such that it does not need an exterior container as discussed below.

Furthermore, Tansill fails to disclose a method of forming a tubular sleeve on a writing instrument including separating first and second ends of a tubular member to

define a passageway in fluid communication with a cavity. Tansill discloses a method of making a molded article from a curable material that may be used to make a shoe insert. Tansill fails to disclose or suggest forming a tubular sleeve on a writing instrument including separating first and second ends of a tubular member, let alone separating the first and second ends to form a passageway in fluid communication with a cavity, as recited by each of claims 64-69.

Because the cited art fails to disclose or suggest a method of forming a tubular sleeve on a writing instrument including separating first and second ends of a tubular member to define a passageway, none of claims 64-69 are rendered obvious by any combination thereof. Thus, the applicants respectfully request withdrawal of the rejections of claims 64-69.

An advantage of a passageway in fluid communication with a cavity, as recited by the claims of the instant application, is that a passageway in fluid communication with a cavity provides a much larger area for injecting a formable material into the cavity formed between the first and second ends of the tubular member. Thus, the formable material may be inserted into the cavity more quickly and air may be discharged from the cavity through the sealable passageway while simultaneously filling the cavity. In contrast, the Hashimoto device must be filled with fluid using one or two syringes, a relatively inefficient way to fill a chamber with fluid. Moreover, air must be removed from the chamber 6 of the Hashimoto device with the syringe before filling the chamber 6 with fluid. *See*, Hashimoto col. 10, lines 27-32.

NO MOTIVATION TO COMBINE THE REFERENCES

The examiner has failed to show particular motivation within the references to combine Hashimoto with either David or Tansill. In fact, one of ordinary skill in the art would not combine Hashimoto with either David or Tansill for the following reasons. The Hashimoto device includes an elastic envelope 35 filled with a fluid that forms a grip that is deformable under pressure and resiliently returns to its original configuration when the pressure is removed (col. 3, lines 4-15). In contrast, both David and Tansill disclose devices that utilize an initially moldable material that becomes a non-flexible, stable mass (after curing). *See*, David abstract, Tansill abstract. As a result, the David and Tansill devices do not return to their original

configurations, and are not constrained by the same structural considerations. For example, the Tansill device can be dismembered such that the insert is removed from the membrane. *See* Tansill, col. 11, lines 39-42. Thus, there is no motivation for one of ordinary skill in the art to modify the Hashimoto device to include any feature of either David or Tansill because both David and Tansill disclose devices having features that would render the Hashimoto device inoperable for its disclosed function. For this additional reason, none of claims 60 and 64-69 can be rendered obvious over any combination of Hashimoto, David and Tansill.

CONCLUSION

In light of the foregoing amendments and arguments, reconsideration and favorable action is respectfully solicited.

Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, he is respectfully invited to contact the undersigned attorney at the indicated telephone number.

Respectfully submitted,

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AMENDMENTS TO THE DRAWINGS

Please amend the drawings as shown on the enclosed replacement sheet, where FIG. 7A is amended to include a tube having reference number 350.